



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re PATENT APPLICATION of:

**Chidiac, et al.**

Serial No.: 09/730,219

Group Art Unit: 2162

Filed: December 5, 2000

Examiner: Shahid Al Alam

For: **METHOD, SYSTEM AN PROGRAM  
PRODUCT FOR DETERMINING A FILE  
FORMAT FOR USE IN A TRANSLATION  
OPERATION**

January 29, 2007

**REPLY BRIEF**  
(With Request for Oral Hearing)

Commissioner of Patent  
and Trademarks  
Alexandria, VA 22314

Pursuant to 37 CFR §41.41, applicants reply to the examiner's answer mailed November 29, 2006. This reply is made based on the examiner's characterization of applicants' arguments.

A REQUEST FOR ORAL HEARING (along with a \$1000 fee under 37 CFR §41.20(b)(3)) is submitted in a separate paper in accordance with 37 CFR §41.47.

**RESPONSE TO EXAMINER'S ARGUMENTS**

**ARGUMENT A**

In response to applicants' argument that the quoted passage relied upon by the examiner (Page 3, 2<sup>nd</sup> ¶) is not, in fact, "admitted prior art," the examiner quotes 37 CFR §§1.97 and 1.98 (which defines requirements of an Information Disclosure Statement (IDS)). These remarks are preceded by a discussion of the layout of a specification, particularly the "Field of Invention" and "Description of Related Art" contained in the background section of the specification. The examiner quotes that part of the IDS regulations directed to how applicants should characterize any known prior art. Here, there is an inference that IDS

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requirements of 37 CFR §§ 1.97 and 1.98 dictate the form and substance of the background section of applicants' specification. To support this inference, the examiner additionally quotes MPEP §§ 608.01(a), 608.01(p) and 707.05(b), which respectively set forth suggested forms of a patent specification, completeness thereof, and the manner of citation of related art by applicants. Then, in an apparent "leak-frog" attempt to impose IDS requirements on the form of a specification to support his rejection, the examiner cites MPEP §2111 [R-1] for the proposition that he is entitled to give the claim limitations their broadest reasonable interpretation.

In reply, the IDS requirements do not control the form or content of applicants' specification in a way to permit the examiner to construe certain disclosure as "admitted prior art." On the contrary, MPEP §608.01(a) (which follows 37 CFR §1.77) merely provides a *recommended* but not a *mandatory* arrangement of the specification.

37 CFR §1.77(b)(2) provides:

(b) The specification should include the following sections in order:

- (1) Title ...
- (2) Cross-Reference ...
- (3) Statement Regarding federally sponsored research ...
- (4) The names of the parties to a joint research agreement ...
- (5) Reference to a "Sequence Listing" ...
- (6) Background ...

The MPEP section dealing with the background section of the specification is also cast in *recommended* rather than *mandatory* language, as follows:

**608.01(c) Background of the Invention**

The Background of the Invention ordinarily comprises two parts:

- (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions. The statement should be directed to the subject matter of the claimed invention.
- (2) Description of the related art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A paragraph(s) describing to the extent practical the state of the prior art or other information disclosed known to the applicant, including references to specific prior art or other information where appropriate. Where applicable, the problems involved in the prior art or other information disclosed which are solved by

the applicant's invention should be indicated. See also MPEP § 608.01(a), § 608.01(p) and § 707.05(b). summary should be more than a mere statement of the objects of the invention, which statement is also permissible under 37 CFR 1.73. The brief summary of invention should be consistent with the subject matter of the claims. Note final review of application and preparation for issue, MPEP § 1302.

Thus, nothing in the USPTO rules or regulations mandate that applicants exclude characterizing their invention or the problems solved thereby in the background section of the specification, or be subject to a risk that such statement be deemed admitted prior art. To hold otherwise would unjustly work against all patent applicants, whether they are U.S., foreign, pro se, or others who intentionally or inadvertently use their own guidelines to prepare their patent specifications. Simply put, the examiner erroneously imputes "admitted prior art" status to applicants' disclosure at Page 3, which is not justified when the overall disclosure clearly indicates that the alleged prior art is, in fact, part of the invention claimed.

#### **ARGUMENT B**

Applicants argue that Ogawa et al. fail to show "determining an optimal starting format" from which to begin a translation. In response, the examiner, at Page 10, states that Ogawa discloses a method, system and apparatus, similar to instant invention for automatically... translating the data to the specific format (*optimal format*) needed by the particular recipient." This statement, however, conflicts with the examiner's statement at Page 4 of his brief, i.e., "Ogawa does not explicitly teach an optimal file format ... [but] APA discloses claimed optimal file format..." Despite the apparent confusion, Ogawa clearly lacks the disputed claim limitation, e.g., determining an optimal starting file format.

#### **ARGUMENT C**

The examiner's comments here appear to parallel Argument B but further reveal an apparent misunderstanding of the invention. Claim 1, for example, recites "determining an optimal file format ... from a plurality of stored file formats ... for use in performing said translation..." In his brief, the examiner states that Ogawa shows "translating the data to the specific form (optimal format) needed by the particular recipient." Claim 1, on the other

hand, requires determining an optimal format from a *plurality* of formats whereas Ogawa (according to the examiner) translates the legacy file to *single common format* and then selects the single common format as the *optimal format* for conveyance to the recipient. According to the examiner's own analysis, Ogawa (assuming it showed determining an optimum format) clearly fails to teach determining from a *plurality* of formats, as claimed.

#### **ARGUMENT D**

The examiner's comments appear superfluous in light of his statements in relation to Argument A, above. As such, applicants adopt the comments set forth in Argument A above.

#### **ARGUMENT E**

This was mistakenly labeled Argument D by the examiner. Here, applicants argue that "nothing in Ogawa is said about determining an optimal one of multiple formats [from which] to begin a translation." In response, the examiner rehashes his prior comments and emphasizes certain features Ogawa having nothing to do with analysis of multiple file formats to determine which format may be optimally converted or translated. More importantly, the examiner has already confirmed that Ogawa fails to teach determining an *optimal format* (See reply to Argument B where the examiner states, at Page 4 of his brief, i.e., "Ogawa does not explicitly teach an *optimal file format* ... [but] APA discloses claimed optimal file format....")

#### **CONCLUSION**

No new arguments have been made. The rejection should not be sustained.

Respectfully submitted,  
McINTYRE HARBIN & KING



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